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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,695	03/03/2004	Valerie Jeanne-Rose	05725.0926-01	4329

22852 7590 08/29/2005

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
LLP  
901 NEW YORK AVENUE, NW  
WASHINGTON, DC 20001-4413

EXAMINER
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VENKAT, JYOTHSNA A

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 08/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/790,695	<b>Applicant(s)</b> JEANNE-ROSE ET AL.	
	<b>Examiner</b> JYOTHSNA A. VENKAT Ph. D	<b>Art Unit</b> 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 50-68 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 50-68 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

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### DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/2/05 has been entered.

Claims 50-68 are pending in the application and the status of the application is as follows:

#### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 50-68 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is new matter rejection.**

4. There is no support in the specification for the expression "where in said composition does not comprise an additional ingredient chosen from functionalized organic polymers, functionalized silicone polymers and precursors thereof".

5. Applicants added this expression in order to overcome the 102 (e) rejection over U. S. Patent 6,352,699 ('699).

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6. In remarks filed with RCE applicants traverse the rejection and point out to various pages in the specification for the support of the negative limitation added where the specification describes the use of various conventional additives, including a number of functionalized organic polymers (e.g., paragraph (040)), functionalized silicone polymers (e.g., paragraph (037)), and precursors thereof, and argue that the present amendment merely excludes from the claims components that are expressly recited as optional in the specification and **admit that even if the terms "functionalized organic polymers" and "functionalized silicone polymers" are not set forth per se in the specification**, one of ordinary skill in the art would recognize a number of such compounds in, for example, paragraphs (037), (040), and (045) and as a result, a genus including each set of species may be excluded by amendment, without raising any issue of new matter herein and cite *In re Johnson* 194 USPQ 187,196.

7. In response to the above argument, the specification at paragraph 37 describes the following polymers

8. *“Partially hydrocarbon-based and/or silicone-based fluoro oils; silicone-based oils, for example poly (C1-C20) alkylsiloxanes, such as polyalkylmethysiloxanes and further such as volatile and non-volatile, linear and cyclic polydimethylsiloxanes (PDMS), such as cyclotetradimethylsiloxane, cyclopentadimethylsiloxane and cyclohexadimethylsiloxane, silicones modified with aliphatic and/or aromatic groups, which may be fluorinated, or with functional groups such as hydroxyl, thiol and/or amine groups, phenylsilicone oils such as polyphenylmethysiloxanes or phenyltrimethicones”*, and paragraph 40 states

9. (040) *For example, a composition 'of the present invention may comprise at least one film-forming material which may be chosen, for example, from alkyd, acrylic and/or vinyl resins,*

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*polyurethanes, polyester-polyurethanes, polyether-polyurethanes, free-radical polymers such as acrylic, styrene-acrylic and/or vinyl polymers, polyesters, celluloses and cellulose derivatives such as nitrocellulose, and resins resulting from the condensation of formaldehyde with an arylsulphonamide* and paragraph 45 states

10. (045) *A composition according to the invention may also comprise any additive known to those skilled in the art as being able to be incorporated in such a composition, such as spreading agents, thickeners, wetting agents, dispersants, antifoams, preserving agents, surfactants, UV screening agents, colorants, cosmetic active agents, vitamins and derivatives thereof, Ceramide, trace elements, moisturizers such as glycerol, waxes, gums, essential oils, DNA and fragrances.*

The above compounds under paragraph 45 do not belong to any class of **“functionalized organic polymers, functionalized silicone polymers and precursors thereof”**. Admitted by applicants there is no description in the specification for the expression that is added to the claims. The Johnson case law supports the examiners position since in Johnson, the compound that was excluded by the proviso is drawn to species and it was described in the specification, where as in the instant application, the genus, which is excluded by the negative limitation claimed in the instant application, is not described and therefore this expression is new matter.

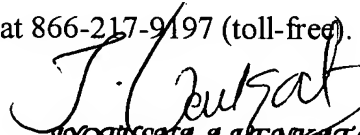
Applicants are notified that if the new matter is deleted, then the 102(e) rejection over the patent '699 will be maintained.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT Ph. D whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K. PAGE can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
JYOTESNA A VENKAT Ph. D  
Primary Examiner  
Art Unit 1615

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